

RESPONSE TO OFFICE ACTION

In the Office Action the Examiner objected claims 1, 7, 8, 13 and 18 due to several informalities. Although the Applicants strongly believe that claims 1, 7, 8, 13 and 18 are clear as originally presented, in an effort to expedite the application to allowance and the fact that the requested changes are directed to form and do not change the scope of the claims, the Applicants have amended the claims as suggested by the Examiner. In view of the foregoing, it is respectfully requested that the objection of 1, 7, 8, 13 and 18 claims be reconsidered and withdrawn.

In the Office action, the Examiner indicated that claims 11- 18, 20 -24 and 30-34 contain allowable subject matter and are patentable over the cited references. The Examiner has objected claims 11-18, 20-24 and 30-34 as being dependent upon a rejected base claim and indicated that these claims would be allowed if rewritten in independent form including the all limitations of the base claim. Claim 1 has been rewritten to include a marking unit in communication with the processor and a feeder attached to an adjustable track. Support for this amendment can be found throughout the specification and in particular claims 1, 11-13. Claims 11-18, 20-24, and 30-

34 have been rewritten as claims 35-54. Support for these new claims can be found throughout the specification and in particular in claims 11-18, 20-24, and 30-34 respectively.

In view of the foregoing, it is respectfully requested that the objection of claims 11-18, 20-24, and 30-34 be reconsidered and withdrawn and new claims 35-54 that have been rewritten to include all of the limitations of the base claim and intervening claims be allowed.

In the office action, the Examiner objected claims 1, 7, 8, 13 and 18 because of several informalities. Although the Applicants strongly believe that claims 1, 7, 8, 13 and 18 are clear as originally presented, in an effort to expedite the application to allowance and the fact that the requested changes are directed to form and do not change the scope of the claims, the Applicants have amended the claims as suggested by the Examiner.

It is respectfully asserted that the changes made to the claims as stated above remove the objections of claims 1, 7,8,13 and 18. Support for these amendments can be found throughout the specification and in the claims as

originally filed. Thus, entry and approval of the same is respectfully solicited and the claims are in condition for allowance.

The Applicants have amended claim 1 to include language directed to a radio frequency driver in communication with said processor, said radio frequency driver configured so as to send signals to said RFID read/write unit for transmission to said RFID containing stock. Support for this amendment can be found throughout the specification and in particular in original claim 3. Claims 2, 4-24 depend either directly from or through an intervening claim on amended claim 1 and therefore contain all of the features, limitations and attributes of claim 1.

As discussed below, the radio frequency driver limitation above is neither taught or suggested by the prior art and therefore claims containing this limitation should be in condition for allowance. The Examiner has acknowledged that this limitation is not taught by Hohberger et al. and relied on Wiklof et al. to fill the technical gap. This rejection is respectfully transversed below.

In the Office Action, the Examiner rejected claims 1, 2 and 19 under 35 U.S.C. 102(e) as being anticipated by Hohberger et al. (US 2003/0063139A1). The Examiner also rejected claims 3-10 and 25-29 under 103(a) as being unpatentable over Hohberger et al. (US 2003/0063139A1) in view of Wiklof et al. (US 6,246,326). For the reasons stated below, the Applicants respectfully assert that the claims as presented and amended are patentable over the cited prior art.

As stated above, claims 1, 2 and 19 have been rejected under 35 U.S.C. 102(e) as being anticipated by Hohberger et al. (US 2003/0063139A1). Claim 1 has been amended to include “a radio frequency driver in communication with said processor, said radio frequency driver configured so as to send signals to said RFID read/write unit for transmission to said RFID containing stock,” which is, as acknowledged by the Examiner on page 4 paragraph 6.

As is well settled, anticipation requires “identity of invention.” *Glaverbel Societe Anonyme v. Northlake Mktg. & Supply*, 33 USPQ2d 1496, 1498 (Fed. Cir. 1995). Each and every element recited in a claim must be found in a single prior art reference and arranged as in the claim. *In re*

Marshall, 198 USPQ 344, 346 (CCPA 1978). There must be no differences between what is claimed and what is disclosed in the applied reference. *In re Kalm*, 154 USPQ 10, 12 (CCPA 1967).” Moreover, it is incumbent upon the Examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference. “*Ex parte Levy*, 17 USPQ2d 1461, 1462 (BPAI 1990). The Examiner is required to point to the disclosure in the reference “by page and line” upon which the claim allegedly reads. *Chong v. Roland*, 17 USPQ2d 1541, 1543 (BPAI 1990). “Anticipation of a claimed product cannot be predicated on mere conjecture as to the characteristics of a prior art product.” *Ex parte Standish*, 10 USPQ2d 1454, 1457 (BPAI 1989).

Claim 1 as amended requires a radio frequency driver in communication with the processor, the radio frequency driver configured so as to send signals to said RFID read/write unit for transmission to the RFID containing stock which the Examiner has stated is not taught by Hohberger et al. (US 2003/0063139A1). Therefore claim 1 as amended is not anticipated by Hohberger et al. (US 2003/0063139A1).

In the office action the Examiner has rejected claims 3-10 and 25-29 under 103(a) as being unpatentable over Hohberger et al. (US 2003/0063139A1) in view of Wiklof et al. (US 6,246,326). For the reasons stated below this rejection too must be removed.

As stated above the Examiner acknowledged that Hohberger et al. did not teach or suggest each and every element of claims 3-10 and 25-29. In particular, the Examiner stated that Hohberger et al. does not specifically disclose a radio frequency driver in communication with the processor unit. The Examiner relied on Wiklof et al. to fill this gap and stated that “it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to further employ an RF driver in addition to the RFID encoding/verifying apparatus of Hohberger et al. due to the fact that more data can be communicated on a radio wave for the purpose of improving programming tasks and printing functions by exchanging data to/from RFID tags and a local area network.” (Emphasis added- See Office Action p. 5 paragraph 1).

As is fundamental, a *prima facie* case of obviousness must be based on facts “cold hard facts.” *In re Freed*, 165 USPQ 570, 571-72 (CCPA

1970). When a rejection is not supported by facts, it cannot stand. *Ex parte Saceman*, 27 USPQ2d 1472, 1474 (BPAI 1993). In order to establish a *prima facie* case of obviousness it is necessary for the Examiner to present evidence preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art that one having ordinary skill in the art would have been *led to do what the applicants have done*. See *Ex parte Levengood*, 28 USPQ2d 1300, 1301 (BPAI 1993); and *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353-54 (Bd. App.1984). In short, the citations must “suggest the desirability of the combination” that is claimed. MPEP 2143.01 at 2100-110, 111 and MPEP 2145 (j) 3 at 2100-127. Statements with regard to relevant skill in the art do not suffice to “bridge over gaps in substantive presentation of an obviousness case.” *Al-site Corp. v. VSI International, Inc.*, 174 50 USPQ2d 1161 (Fed. Cir. 1999).

The Applicants respectfully submit that the cited reference fails not only to disclose or teach each element of the Applicant’s claims, but it also fails to provide the requisite suggestion to do what the Applicants have done. For these reasons alone, the rejection of the claims is insufficient as a matter of law. *Ex parte Levengood*, 28 USPQ2d 1300, 1301-02 (BPAI 1993).

“Obvious to employ” does not release the Examiner of his burden of demonstrating *where* in Wiklof et al. there is a suggestion to make the RFID encoding/verifying apparatus having the limitations required by the claims, and *why* one would have made the RFID apparatus as claimed. The kind of suggestion which would have “*strongly motivated*” one to make the RFID apparatus as claimed. *Ex parte Graselli*, 231 USPQ 393, 394 (Bd. App. 1983). The type of motivation which would have “*impelled*” one to do so (*Levengood*, 28 USPQ2d at 1302), and the type of suggestion that a RFID apparatus having the limitations required by the claims “*should*” be made. *Ex parte Markowitz*, 143 USPQ 303, 305 (Bd. App. 1964). But that, too, is what a conclusion of obviousness requires. See *Levengood*, 28 USPQ2d at 1302. The Examiner has not addressed these elements, but without these elements, obviousness cannot be established.

Moreover, we note that Wiklof et al. does not mention any problem with the printer described in that reference, be it poor performance or otherwise. This is yet another reason why Wiklof et al. does not provide the requisite suggestion or motivation or other reason, including the suggestion of desirability, to be combined with Wiklof et al. as advanced by the Examiner. Moreover, the Examiner’s reason in support of the reference of

the rejection, that the fact that more data can be communicated on a radio wave for the purpose of improving programming tasks and printing functions by exchanging data to/from RFID tags and a local area network “*would have been obvious ... to employ*” is not only the wrong legal standard (See *Ex parte Levengood*, Supra 1301), but also falls short of the requisite suggestion and motivation to do what the Applicants have done which is required to support a rejection under 35 U.S.C. 103.

What the rejection distills down to is that one “would have” or “would have been able to” do what the applicants have done. That, however, is not the standard under 35 U.S.C. 103, and has been long rejected as a substitute for the elements required by the Examiner to meet his burden of establishing a *prima facie* case of obviousness. *Ex parte Levengood*, 28 USPQ2d 1300, 1301 and *Ex parte Markowitz*, 143 USPQ 303, 305 (Bd. App. 1964).

Thus, for all of the foregoing reasons, reconsideration and withdrawal of the rejection of the claims 3-10 and 25-29 over Hohberger et al. in view of Wiklof et al. is respectfully solicited.

Respectfully submitted,

By 

Leo G. Lenna, Esq. Reg. No. 42,726
Law Office of Leo G. Lenna
1 Makamah Beach Road
Northport, NY 11768
1-516-818-4225

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231, on April 27, 2005.

